



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0807-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
) Group Art Unit: 1617
Isabelle ROLLAT-CORVOL et al.)
) Examiner: Shengjun Wang
Application No.: 09/719,101)
)
Filed: February 23, 2001) Confirmation No. 4969
)
For: COSMETIC COMPOSITION COMPRISING AT)
LEAST ONE TACKY POLYMER AND AT) **MAIL STOP AF**
LEAST A FIXING POLYMER)

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated March 3, 2005, and the Advisory Action dated June 15, 2005, Applicants respectfully request reconsideration of this application in view of the following remarks. A Notice of Appeal is filed concurrently herewith.

Claims 38-106 are pending. Claims 59, 61-68, 70-77, 80-82, and 85-87 are withdrawn from consideration by the Examiner as being directed to non-elected subject matter.

I. Double Patenting Rejection Is Improper For Lack Of The Requisite Evidence Of A Suggestion Or Motivation

The Examiner maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under the judicially created doctrine of obviousness-type double patenting

over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. ("*Rollat*"), in view of EP 0 551 749 to Lee et al. ("*Lee*"). Final Office Action, p. 2. Applicants respectfully traverse this rejection for at least the following reasons.

First, contrary to the Examiner's allegation, the tacky polymer claimed in the present invention has "a glass transition temperature (T_g) of less than 20 °C," and therefore, is not exactly the same as the "anionic fixative polymer" defined in claim 12 of *Rollat*. See Response to the Final Office Action filed June 3, 2005, pp. 2 and 3.

Therefore, in an attempt to arrive at the presently claimed invention, one of ordinary skill in the art has to pick and choose certain polymers from the claimed polymer in *Rollat*, and combine such a polymer with the fixing polymer claimed in *Lee*. However, the Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose, let alone evidence of a motivation to particularly combine the anionic fixative polymer claimed in *Rollat* with the fixing polymer claimed in *Lee*. See Request for Reconsideration filed October 21, 2004, p. 3.

Further, Applicants respectfully submit that the Examiner's allegation that *Lee* "is not limited to the claims therein" (Final Office Action, p. 2) is improper. The M.P.E.P. clearly instructs that one significant difference between an obviousness-type double patenting rejection and an obviousness rejection is that "a double patenting rejection must rely on a comparison with the claims in [the prior art] while an obviousness rejection based on the same [prior art] relies on a comparison of what is disclosed (whether or not claimed) in the same [prior art]." M.P.E.P. §804(III) (emphasis added).

II. Rejection Under 35 U.S.C. § 112, First Paragraph, Is Improper Because The Written Description Requirement For A Claimed Genus Can Be Satisfied By Disclosure Of Relevant Physical And/or Chemical Properties

The Examiner maintained the rejection of claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because allegedly the term “tacky polymer” used in the present claims is a functional limitation and its structure-property relationship is not disclosed. Final Office Action, p. 3. Applicants respectfully traverse this rejection for at least the following reasons.

First, the M.P.E.P. clearly instructs that “[t]he written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice . . . or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties[.]” M.P.E.P. §2163 II.A.3(a).ii) (citing *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997)) (emphasis added).

Therefore, contrary to the Examiner’s allegation, it is not necessary to disclose the structure of all chemical compounds in a genus claim in order to satisfy the written description requirement. Disclosure of relevant, identifying characteristics, such as physical and/or chemical properties, can also satisfy the written description requirement.

Here, pages 4-6 of the present description provides guidance on how to determine the maximum peeling force F_{\max} and the energy for separation $E_{s(MV)}$, which are physical properties of the “tacky polymer” as presently claimed. These physical properties are not functional limitations as alleged by the Examiner.

Further, the present specification provides embodiments of the “tacky polymer” as presently claimed, such as branched sulphonic polymers or (meth)acrylic ester

polymers on page 6, lines 21-23, guidance on how to form the branched sulphonic polyester and the (meth)acrylic ester and specific examples thereof on page 7, lines 5 - page 12, line 16. Therefore, the present specification provides sufficient written description.

Finally, the M.P.E.P. clearly instructs that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. M.P.E.P. § 2163(I)(A) (citing *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)). The Examiner has not met the burden to overcome this presumption in the present rejection. See Request for Reconsideration filed October 21, 2004, pp. 4-6. Therefore, this rejection is improper.

III. Rejection Under 35 U.S.C. § 103 (a) Is Improper For Lack of Evidence of A Suggestion Or Motivation

The Examiner also maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. §103 over *Lee* in view of WO 95/18191 to Miller et al. ("*Miller*"). Final Office Action, p. 4. The Examiner further asserted that "in the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists." Advisory Action, p. 2. This issue in the present case is not whether overlap of ranges is obvious as alleged by the Examiner, but whether it would have been obvious to pick and choose the claimed elements from the prior art. Applicants submit that it would not have been obvious for at least the following reasons.

First, the Examiner has failed to point to any evidence of a suggestion or motivation to combine teachings of *Lee* and *Miller*. See Request for Reconsideration filed October 21, 2004, pp. 6-8. Specifically, *Miller* clearly teaches that "[t]he preferred

Tg of the adhesive composition according to the present invention is below 10 °C."

Page 18, lines 1-3. *Miller* further teaches that a "low Tg means that the adhesive compositions will not be brittle[.]" *Id.* at lines 10-11. Therefore, contrary to the Examiner's allegation, the low Tg taught in *Miller* does not refer to the "improved branched sulfonic polyester" but "the adhesive composition" disclosed therein.

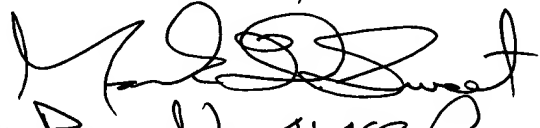
Second, *Lee* teaches away from using Eastman AQ polymers with a Tg lower than 20 °C in combination with its water-soluble amphoteric polymer, such as acrylate copolymers, because *Lee* teaches that among "Eastman AQ polymers," those having "a glass transition temperature ranging from about 50 °C to about 70 °C, preferably around 55 °C" are preferred. Page 3, lines 17-19; see Appeal Brief filed January 7, 2004, pp. 9-10. Therefore, this rejection is improper.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. If there is any fee due in connection with the filing of this paper, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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